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09/509,863
LP4285 US NA
Response to Final Office Action Mailed November 7, 2002
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RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 1771
PATENT

#9 (N.S.) 12/26/02 JR

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of:
KEITH DOUGLAS PERRING, ET AL.

CASE NO.: LP4285 US NA **APPLICATION NO.:** 09/509,863

CONFIRMATION NO.: 2545 **GROUP ART UNIT:** 1771

EXAMINER: JEREMY R. PIERCE **FILED:** JULY 14, 2000

FOR: METHOD FOR TEXTILE TREATMENT FOR SPANDEX CONTAINING FABRICS

RESPONSE TO FINAL OFFICE ACTION

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

This is Applicants' response to the Final Office Action dated November 7, 2002. Claims 1 to 11 are pending in the form as set forth in attached Appendix I. Applicants respectfully request reconsideration of patentability based on the following remarks.

The Invention

The present invention is based on the surprising discovery that, when treated with certain categories of perfumes, spandex-containing textiles behave differently than spandex-free textiles. When treated with fragrances specified in the present invention, spandex-containing textiles show enhanced deposition and retention of perfume after washing and reduce malodorous intensity.

Rejection of Claims 1-11 under 35 USC § 112, second paragraph

The Examiner maintains a rejection of pending claims 1-11 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. It is the Examiner's position that pending claims 1-11 are invalid as vague and indefinite because they set forth properties rather than compositions. Applicants respectfully

traverse this rejection with respect to all pending claims and request the Examiner to reconsider.

The pending claims recite two categories of fragrances. Fragrances of Category A are hydroxylic materials which are alcohols, phenols, or salicylates having specified octanol /water partition coefficients and Kovats indices. Fragrances of Category B are esters, ethers, nitriles, ketones and aldehydes having specified octanol /water partition coefficients and Kovats indices. Accordingly, the pending claims recite fragrances by both chemical class (alcohol, phenol, salicylate, ester, ether, nitrile, ketone, aldehyde) and by physical property (octanol/water partition coefficient and Kovats index), therefore, the claims clearly define and distinctly claim methods of treating textiles and fibers with specific fragrance materials and the resulting textiles and fibers. Applicants note that claims are not indefinite merely because they define compounds by chemical class. See, for example, M.P.E.P. § 2173.04 ("Breadth Is Not Indefiniteness"):

> If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. § 112, second paragraph.

The PTO Board's decision in *Ex Parte Slob*, 157 U.S.P.Q. (BNA) 172 (1967) does not compel a different result. The Examiner correctly notes that, in *Ex Parte Slob*, the Board concluded that a claim was indefinite because it defined a component only by its physical property (liquefaction temperature). However as noted above, Applicants' pending claims describe the fragrances both by chemical class and by two physical properties. While it is true that, in *Ex Parte Slob*, the Board also sustained a rejection of a dependent claim that further defined the component by its chemical class ("a hydrated inorganic salt"), that was not because the claim was indefinite *per se* but because there was evidence in the record that inoperable materials fell within this chemical class. There is no evidence that fragrances belonging to the chemical classes recited in Applicants' pending claims are inoperable. Accordingly, the situation before the Examiner is far different from that before the Board in *Ex Parte Slob*.

Applicants respectfully request that the Examiner reconsider his position and withdraw the rejection based upon §112 as to all pending claims.

Rejection of Claims 1-11 under 35 USC § 103(a)

In the Final Office Action, the Examiner maintained the rejection of claims 1 to 11 as being obvious over U.S. Patent No. 4,882,220 ("Ono") in view of U.S. Patent No. 5,008,517 ("Brekkestran"). Applicants respectfully traverse this rejection with respect to all pending claims and request the Examiner to reconsider.

Ono is directed to improving the fragrant properties of fabrics. Ono is based on the discovery that fragrant properties improve when fabrics are treated with microencapsulated perfumes containing certain resinous binders. Ono does not discuss treating spandex fabrics or fibers and teaches away from directly applying fragrances to textiles.

Brekkestran describes electrically heated form-fitting undergarments for sportsmen, construction workers, military personnel and the like (Col. 1, lines 25-39). The Brekkestran undergarments are preferably lightweight, stretchable and have a plurality of discrete zones that are electrically heated (Col. 2, lines 13-18). Spandex is one of the preferred fabrics used in the substrate that carries the electrical heating elements (Col.3, line 11-13).

Applicants' response, filed September 17, 2002 and incorporated herein by reference, noted that the Examiner had not provided any reasons, beyond the teaching of Applicants' own disclosure, why an artisan of ordinary skill would be motivated to combine Ono with Brekkestran. In the Final Office Action, the Examiner stated that the motivation to combine the two references was the desire to improve the elasticity of the fabric of Ono. Applicants disagree that the prior art contains such motivation.

> The mere fact that reference can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. § 2143.01 (citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d (BNA) 1430 (Fed. Cir. 1990)).

There is no mention or suggestion in Ono that it would be desirable to improve the elastic properties of the fibers. Further, there is no mention or suggestion in Brekkestran that it would be desirable to add fragrance to the electrically heated form-fitting undergarments. Indeed, only Applicants' specification provides such motivation which, although understandably difficult, must be ignored when forming a *prima facie* case of obviousness See, M.P.E.P. § 2142 ("Knowledge of the applicant's disclosure must be put aside").

Further, as Applicants noted previously, even if there was proper motivation to combine these references (an assertion which Applicants disagree), the Examiner has not provided an explanation for how the combination would have led the skilled artisan to recognize the specific categories and physical properties of fragrances that Applicants demonstrated are useful on spandex-containing textiles as opposed to spandex-free textiles. Combining the spandex from Brekkestran with the teachings of Ono reveals nothing about the specific fragrances claimed by Applicants. Accordingly, claims 1 through 11 are patentably distinct from Ono and Brekkestran, alone or in combination, and should be allowed.

Should the Examiner have any questions or wish to discuss any aspect of the case, he is invited to contact Applicants' representative at (302) 892-7910.

No fees are believed due. Nevertheless, should the Commissioner determine that any fee is due before the Examiner may consider this Amendment, including a fee for an extension of time, such extension is requested and the Commissioner is authorized to charge the fee to Deposit Account No. 04-1928 (E.I. DuPont de Nemours and Co.).

Respectfully submitted,

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DATE: DECEMBER 18, 2002

Enclosure: Appendix I